



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/526,031

03/15/2000

Jonathan J. Hull

74451.P114

9293

7590

11/26/2008

Michael J Mallie
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard 7th Floor
Los Angeles, CA 90025

EXAMINER

TRAN, QUOC A

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

11/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/526,031	Applicant(s) HULL ET AL.	
	Examiner Quoc A. Tran	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,8-13,16,17,20-25,28,29,32-36 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8-13,16,17,20-25,28,29,32-36 and 44-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is a Non-Final Office Action in response to Applicants' RCE filed on 10/06/2008 and Applicants' Amendment/Remarks filed 09/09/2008. Claims 1, 4-5, 8-13, 16-17, 20-25, 28-29, 32-36, and 44-52, are pending. Claims 1, 13 and 25 are currently amended. Claims 2-3, 6-7, 14-15, 18-19, 26-27, 30-31, and 37-43 were previously canceled. Effective filing date is **03/15/2000**, (Assignee: Ricoh).

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/06/2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- ❖ Claim(s) 1, 4-5, 8-13, 16-17, 20-25, 28-29, 32-36, and 44-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **written description**

Art Unit: 2176

requirement. The claim contains subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

- ❖ Additionally, Claims Claim(s) 1, 4-5, 8-13, 16-17, 20-25, 28-29, 32-36, and 44-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **enablement requirement.** The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- Independent claims 1, 13 and 25 recite the limitations “*the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document*”, this limitation was not in the original disclosure (see the amended portions of claims 1, 13 and 25 in the listing of the claims Pages 2, 5, and 8).
- There is **no** mention in the original disclosure of making any “*without having to access resources outside of the first multimedia document*” The phrase “*without having to access resources outside of the first multimedia document*” or any variant thereof, is not mentioned in the original disclosure of the present application. Similarly, in the context of the language recited in Claims 1, 13 and 25 (see the claims Pages 2, 5, and 8).

it is noted, the specification indicates a method of creating a multimedia annotation for a paper document and creating a first multimedia document by combining the paper document and the multimedia annotation represented by a first bar code encoding the at least one of the audio sound and video clip, wherein the video and/or audio are stored on a portable storage device or on a network or server [emphasis added], See Applicant's Specification at Pages 9, Line 1 through Pages 10, line 20.

As recognized by the Examiner, a first multimedia document being created by combining the paper document and the multimedia annotation represented by a first bar code encoding the audio sound and video clip, wherein the video and/or audio are stored on a portable storage device or on a network or server, wherein the video and/or video is not stored on the first multimedia document, but rather resided on the a portable storage device or on a network or server that is accessible upon request by activating the bar code which is encoded and printed onto the first multimedia document, see Claims 1, 13 and 25 in lighted of the Applicants' Specification at Pages 9, Line 1 through Pages 10, line 20.

Accordingly, Claims 1, 4-5, 8-13, 16-17, 20-25, 28-29, 32-36, and 44-52 fail to comply with the **written description requirement**.

In addition to not mentioning that “*the audio sound can be extracted directly from the first bar code* **without having to access resources outside of the first multimedia document**” is made, the original disclosure does not mention **how** such accessing audio and/or video would be **made** and **use**.

Thus, Claims -5, 8-13, 16-17, 20-25, 28-29, 32-36, and 44-52 fail to comply with the ***enablement requirement***.

In addition,

❖ The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5, 8-13, 16-17, 20-25, 28-29, 32-36, and 44-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 13 and 25 recite the phrase “*the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document*”, (see the amended portions of claims 1, 13 and 25 in the listing of the claims Pages 2, 5, and 8).

This limitation is indefinite because it is unclear the metes and bounds of the claimed invention. Since phrase “*the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document*” or any variant thereof, is not mentioned in the original disclosure of the present application.

Applicant must amend the limitation to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention.

If the examiner has overlooked the portion of the original disclosure that describes this feature of the present invention and how to make and use this feature of

Art Unit: 2176

the present invention, then Applicant should specifically point it out (by page number and line number) in the response to this Office Action.

In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 112.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 8, 13, 16, 20, 25, 28, 32 and 44-52 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over **Morris** et al US005420974A issued 05/30/1995 (hereinafter Morris), in view of **Hoda** et al US004831610 filed 03/03/1987 (hereinafter Hoda).

Regarding independent claim 1: Morris teaches:

a method comprising: creating a multimedia annotation for a paper document, the multimedia annotation representing at least an audio and a video clip;

Art Unit: 2176

(See Morris at Fig/ 9A-B and Col. 2, Lines 35-40, discloses scanned-in form, and are stored in a mixed object document content architecture envelope (MODCA). Morris further discloses, if the box being defined is a check box, then the sub-type is defined as audio, video, image, text, or other type object. The resulting directory and the image object of the overall scanned-in form are stored in a mixed object document content architecture envelope (MODCA)-see Morris at Col. 2 Lines 20-30.)

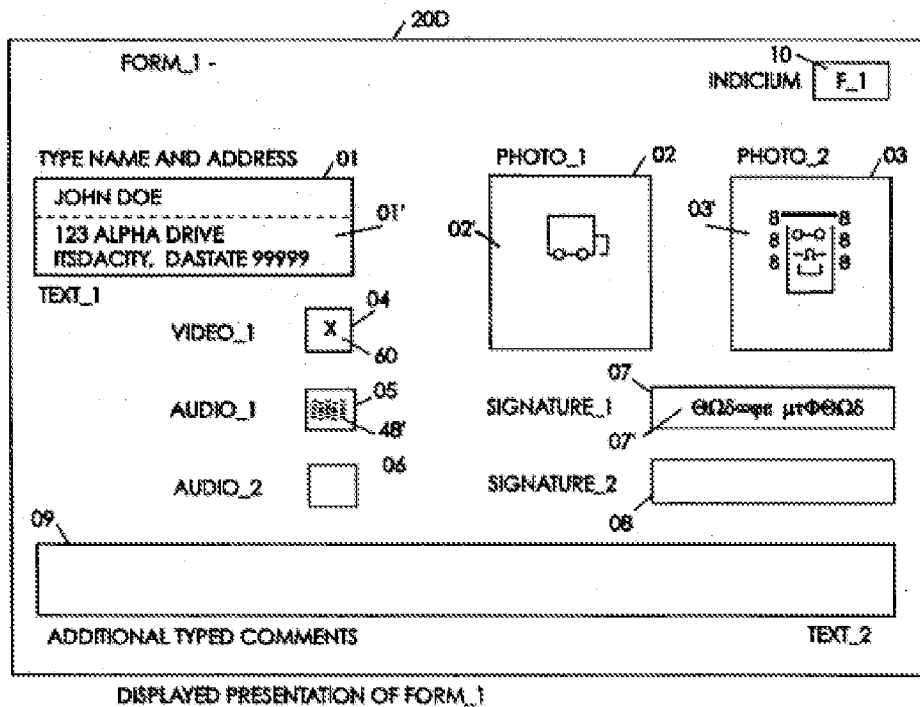
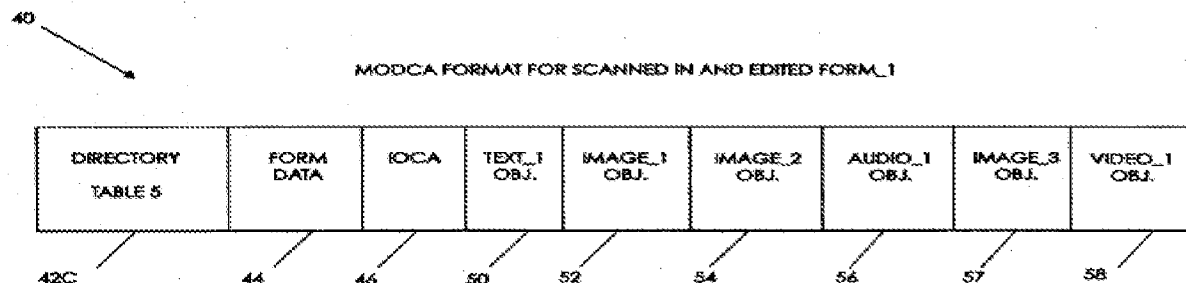


FIG. 9A

FIG. 9B



creating a first multimedia document by combining the paper document and the multimedia annotation represented by the audio sound and video clip,

(See Morris at Col. 2, Lines 35-40, discloses scanned-in form, are stored in a mixed object document content architecture envelope (MODCA). Morris further discloses, if the box being defined is a check box, then the sub-type is defined as audio, video, image, text, or other type object. The resulting directory and the image object of the overall scanned-in form are stored in a mixed object document content architecture envelope (MODCA)-see Morris at Col. 2 Lines 20-30.)

wherein the first multimedia document is generated as a part of reproducing the paper document via a document reproduction system, wherein the multimedia annotation is captured via an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system, wherein the captured multimedia annotation is encoded,

(See Morris at Col. 2, Lines 35-40, discloses scanned-in form, are stored in a mixed object document content architecture envelope (MODCA). Morris further discloses, if the box being defined is a check box, then the sub-type is defined as audio, video, image, text, or other type object. The resulting directory and the image object of the overall scanned-in form are stored in a mixed object document content architecture envelope (MODCA)-see Morris at Col. 2 Lines 20-30.

Also see Morris at Col. 2, Lines 25-40, discloses a filled-out hard copy of the form is desired to be entered into the image archiving system, the filled-out copy of the master form is scanned-in to the system. A special indicium is associated with each master form, which uniquely identifies that form and distinguishes it from all other master forms created for the system. The system reads the indicium from the scanned-in form and then accesses the MODCA envelope the directory for the master form is then accessed to obtain the coordinates of each component field on the scanned-in form. Then access the stored nonvisual object and play it back for the operator- See Morris at the Abstract.)

wherein the first multimedia document, which when scanned by a process, the process causes the printed multimedia annotation to be decoded, the at least one of the audio sound and video clip to be extracted from the multimedia annotation,

(See Morris at Col. 2, Lines 25-40, discloses a filled-out hard copy of the form is desired to be entered into the image archiving system, the filled-out copy of the master form is scanned-in to the system. A special indicium is associated with each master form, which uniquely identifies that form and distinguishes it from all other master forms created for the system. The system reads the indicium from the scanned-in form and then accesses the MODCA envelope the directory for the master form is then accessed to obtain the coordinates of each component field on the scanned-in form.)

and the extracted audio sound and video clip can be played via a multimedia player.

(See Morris at Col. 3, Lines 35-45, discloses when the check box is selected, the multimedia record is accessed from the MODCA envelope, for example, and is played. If it is an audio record, then the sound is played for the operator. If it is a video record, then a video cameo display window can be presented to the operator on the display screen and the video sequence played (i.e. played via a multimedia player).

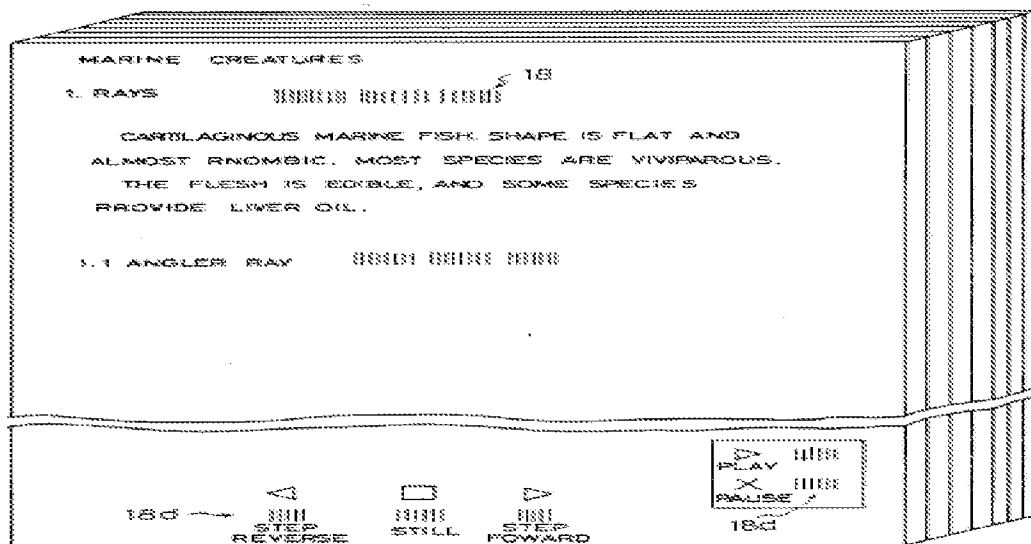
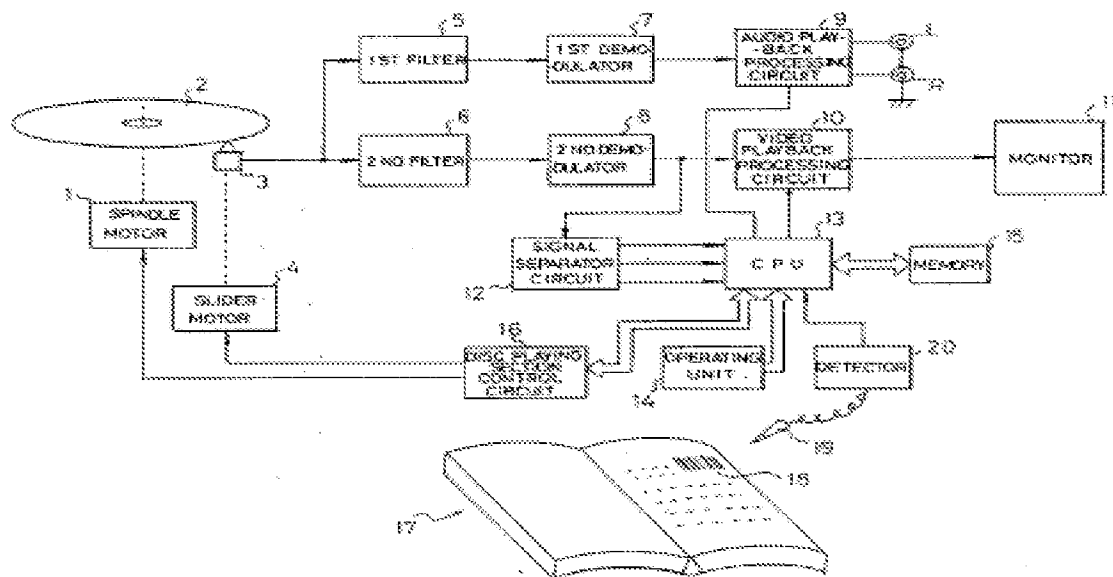
In addition, Morris does not expressly teach, but Hoda teaches:

and multimedia annotation represented by a first bar code, wherein the captured multimedia annotation is encoded within the first bar code, and wherein the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document.

(See Hoda at Col. 1 Lines 25-40, described a bar code which is printed close to an item published on a legible recording medium [dictionaries, catalogs, guidebooks, etc., generally contain a number of photographs and other pictures and diagrams relating to descriptions, guidance material etc. which appear in the printed text, see Col. 1, Lines 15-20], recognition is performed of an operating command which is indicated by the printed bar code, whereby a data recording medium playback apparatus is controlled such as to execute playback of video or audio data relating to that item. Also Hoda further discloses an example of a page in guidebook 17. Numeral 18 denotes code data

Art Unit: 2176

printed on that page, which in this example is in the form of bar code data, (referred to in the following simply as bar code), which contains codes respectively expressing a media player to playback the video or audio data relating to that item. This is generally disclosed at Col. 5, lines 9-27 and at Fig. 2.



Therefore, the artisan would have well appreciated that Hoda's method of captured video or audio annotation is encoded as a bar code, and can be extracted directly from the bar code without having to access resources outside of the first multimedia document as cited in independent claim 1.

This interpretation is supported by the applicant's disclosure, which is stated, "*the user generates the multimedia annotation on a workstation, records it on a portable storage device all the available multimedia annotations stored on the portable storage device and allow the user to review and select them*", See Applicant's Specification at Page 9, Lines 4-20.)

Accordingly, It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morris's check box and the sub-type is defined as audio, video, image, text, or other type object scanned-in form, are stored in a mixed object document content architecture envelope (MODCA), to include a means of utilizing the barcode as taught by Hoda, so that, when selected by a user (i.e. scanned document with the box is check as taught by Morris) the barcode would accessing the audio sound without having to access resources outside of the first multimedia document (Hoda at col.1, line 25 through col. 2. line 60).

Regarding independent claim 13,

Is directed to machine-readable medium providing instructions, which when executed by a set of one or more processors to perform the method of

Art Unit: 2176

claim 1 which cites above, and is similarly rejected under the same rationale,

Also See Morris at Fig. 1 and also at Col. 5, Lines 10-20.

*Regarding **independent claim 25**,*

Is directed to a computer system include a bus, a data storage, and a processor to perform the method of claim 1 which cites above, and is similarly rejected under the same rationale, Also See Morris at Fig. 1 and also at Col. 5, Lines 10-20.

*Regarding **claims 4, 16, and 28**,*

Morris and Hoda teach the method of claims 1, 13 and 25 and further comprise:

wherein a location indicator associated with the multimedia annotation is placed on the first multimedia document, wherein the location indicator indicates where the multimedia annotation can be retrieved and played.

(See Morris at Col. 3, Lines 35-45, discloses when the check box is selected, the multimedia record is accessed from the MODCA envelope, for example, and is played. If it is an audio record, then the sound is played for the operator. If it is a video record, then a video cameo display window can be presented to the operator on the display screen and the video sequence played (i.e. played via a multimedia player).

Regarding claims 8, 20, and 32,

Morris and Hoda teach the method of claims 1, 13 and 25 and further comprise:

creating a second multimedia document by combining the image of the paper document and the multimedia annotation; and storing the image of the paper document and the multimedia annotation in a storage, wherein the second multimedia document is an electronic document associated with the first multimedia document which is a physical document.

(See Morris at Col. 2, Lines 35-40, discloses scanned-in form, are stored in a mixed object document content architecture envelope (MODCA). Morris further discloses, if the box being defined is a check box, then the sub-type is defined as audio, video, image, text, or other type object. The resulting directory and the image object of the overall scanned-in form are stored in a mixed object document content architecture envelope (MODCA)-see Morris at Col. 2 Lines 20-30.

Also see Morris at Col. 2, Lines 25-40, discloses a filled-out hard copy of the form is desired to be entered into the image archiving system, the filled-out copy of the master form is scanned-in to the system. A special indicium is associated with each master form, which uniquely identifies that form and distinguishes it from all other master forms created for the system. The system reads the indicium from the scanned-in form and then accesses the MODCA envelope the directory for the master form is then accessed to obtain the coordinates of each component field on the scanned-in form. Then access the stored nonvisual object and play it back for the operator- See Morris at the Abstract.)

generating an image of the paper document, the image of the paper document being unconsciously captured via the document reproduction system during the reproduction of the paper document without user intervention;

(See Morris at Col. 2, Lines 25-40, discloses a filled-out hard copy of the form is desired to be entered into the image archiving system, the filled-out copy of the master form is scanned-in to the system. A special indicium is associated with each master form, which uniquely identifies that form and distinguishes it from all other master forms created for the system. The system reads the indicium from the scanned-in form and then accesses the MODCA envelope the directory for the master form is then accessed to obtain the coordinates of each component field on the scanned-in form. Then access the stored nonvisual object and play it back for the operator- See Morris at the Abstract.)

*Regarding **claim 44**, Morris teaches:*

wherein the first multimedia document is a physical document having the first check box printed thereon, which when scanned by a scanning device, causes the first check box to be decoded and the audio sound to be extracted from the first check box, and wherein the extracted audio sound is capable of being played via an audio player.

(See Morris at Col. 3, Lines 35-45, discloses when the check box is selected, the multimedia record is accessed from the MODCA envelope, for example, and is played. If it is an audio record, then the sound is played for the operator. If it is a video record,

Art Unit: 2176

then a video cameo display window can be presented to the operator on the display screen and the video sequence played (i.e. played via a multimedia player).

In addition, Morris does not expressly teach, but Hoda teaches:

bar code,

(See Hoda at Col. 3 Lines 60-65, discloses high density barcodes.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morris's check box and the sub-type is defined as audio, video, image, text, or other type object scanned-in form, are stored in a mixed object document content architecture envelope (MODCA), to include a means of utilizing the barcode as taught by Hoda, so that, so that, when selected by a user (i.e. scanned document with the box is check as taught by Morris) the barcode would accessing the audio sound without having to access resources outside of the first multimedia document (Hoda at col.1, line 25 through col. 2. line 60).

*Regarding **claim 45**, Morris teaches:*

**capturing an audio sound of the multimedia annotation from a user
using a microphone of the input device to annotate the paper document to
create a multimedia paper document.**

(See Morris at Col. 2, Lines 5-20, discloses sound records, Video records, sequential animation sequence records, and the like, such multimedia objects being characterized in that their presentation requires duration of time. It is within the scope of the invention

Art Unit: 2176

that check boxes can also be used to represent visual fields such as other image objects, other text objects, other vector graphics objects, etc. Morris at Col. 3 Lines 10-15, discloses the steps that allow a user to add new recorded segments of audio, video, etc. for any page of data. It is inherently including the use of Microphone and Video camera in order to record sound and Video as taught by Morris.)

*Regarding **claim 46**, Morris teaches:*

wherein the microphone is automatically activated when the user selects a reproduction function of the document reproduction system to reproduce the paper document.

(See Morris at Col. 2, Lines 17 -60, discloses sound records, Video records, sequential animation sequence records, and the like, such multimedia objects being characterized in that their presentation requires duration of time. It is within the scope of the invention that check boxes can also be used to represent visual fields such as other image objects, other text objects, other vector graphics objects, etc. Morris at Col. 3 Lines 10-15, discloses the steps that allow a user to add new recorded segments of audio, video, etc. for any page of data. It is inherently including the use of Microphone and Video camera in order to record sound and Video as taught by Morris. Also Morris discloses if the object is a nonvisual field object, such as a voice object, then the operator is prompted to input the voice record. Also, the audio check box corresponding to the audio record is highlighted- see Morris at Col. 4 Lines 1-15.)

Claim 47, Morris teaches:

**capturing a video clip of the multimedia annotation from a user
using a video camera of the input device to annotate the paper document
to create a multimedia paper document.**

(See Morris at Col. 2, Lines 5-20, discloses sound records, Video records, sequential animation sequence records, and the like, such multimedia objects being characterized in that their presentation requires duration of time. It is within the scope of the invention that check boxes can also be used to represent visual fields such as other image objects, other text objects, other vector graphics objects, etc. Morris at Col. 3 Lines 10-15, discloses the steps that allow a user to add new recorded segments of audio, video, etc. for any page of data. It is inherently including the use of Microphone and Video camera in order to record sound and Video as taught by Morris.)

Claim 48, Morris teaches:

**wherein the video camera is automatically activated when the user
selects a reproduction function of the document reproduction system to
reproduce the paper document.**

(See Morris at fig. 9 and Col. 9, Line 45 through Col. 10, Line 5, discloses Step 1040 determines whether a video check box has been marked. In the example shown in FIG. 9A, the video check box 04 has been marked with the mark X which is reference 60. Step 1040 then prompts the operator to input the video record. Step 1042 forms a video object content architecture (VDOCA) object 58. Step 1044 stores the object 58 in the

Art Unit: 2176

MODCA envelope 40, as is shown in FIG. 9B and adds the object name " VIDEO-1" as the pointer in the check box 04 line of the directory 42C (Table 5). It then adds the object name " VIDEO-1" and the media address " MODCA-VOCA" in the video data line of the directory 42C (Table 5). It is inherently including the use of Microphone and Video camera in order to record sound and Video as taught by Morris.)

Claim 49, Morris teaches:

**in response to a request to retrieve a second multimedia document,
performing a content-based search for the requested multimedia document
within the storage based on the content of the multimedia annotation
associated with the requested multimedia document.**

(See Morris at Col. 3, Lines 35-45, discloses when the check box is selected, the multimedia record is accessed from the MODCA envelope, for example, and is played. If it is an audio record, then the sound is played for the operator. If it is a video record, then a video cameo display window can be presented to the operator on the display screen and the video sequence played (i.e. played via a multimedia player).

Claims 50-52, Morris teaches:

**wherein the content-based search is performed by OCR, audio
speech recognition, or video face recognition techniques on the
multimedia annotations of the multimedia documents being searched,**

Art Unit: 2176

(See Morris at Col. 2, Lines 35-40, discloses scanned-in form (I.e. OCR), are stored in a mixed object document content architecture envelope (MODCA). Morris further discloses, if the box being defined is a check box, then the sub-type is defined as audio, video, image, text, or other type object. The resulting directory and the image object of the overall scanned-in form are stored in a mixed object document content architecture envelope (MODCA)-see Morris at Col. 2 Lines 20-30.)

Claims 5, 9-11, 17, 21-23, 29 and 33-35 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over **Morris** et al US005420974A -issued 05/30/1995 (hereinafter Morris), in view of **Hoda** et al US004831610 filed 03/03/1987 (hereinafter Hoda), further in view of **Schena** et al US006448979B1 filed 01/25/1999 (hereinafter Schena).

*Regarding **claims 5, 17, and 29,***

Morris and Hoda do not expressly teach, but Schena teaches:

wherein the location indicator comprises a first Uniform Resource Locator (URL), and a second bar code, wherein the first URL is indicated in plain text, and wherein the second bar code represents the first URL in an encrypted form.

(Schena col. 4, lines 45-55, discloses the link information corresponding to the provider information may include a universal resource locator (URL) (Schena col.1, line 64 through col. 2. line 40). In addition, the links can be encoded according to provider, for

Art Unit: 2176

example UPC or ISBN numbers and any code may serve as the alphanumeric sequence.

Also See Schena at Col. 3 Lines 60-65, discloses high density barcodes.

Under the broadest reasonable interpretation, The Examiner equates the claimed **bar code** as equivalent to the UPC or ISBN numbers and any code as taught by Schena.

This interpretation is supported by Applicant's Specification, which states "*The annotation may be in different forms, such as, for example, a bar code containing an audio message or a URL indicating a link to a video clip*" at page 7 lines 15-18.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify schena's user selectable object (i.e. the location indicator comprises a first Uniform Resource Locator (URL), and a second bar code, wherein the first URL is indicated in plain text, and wherein the second bar code represents the first URL in an encrypted form) providing a user with access to the portion of the recorded information corresponding to the visual feature (i.e. machine readable barcode), to include a means of selecting by a user onto a check box, the sub-type is defined as audio, video, image, text, or other type object scanned-in form, are stored in a mixed object document content architecture envelope (MODCA) as taught by Morris and Hoda. One of ordinary skill in the art would have been motivated to modify this combination because Schena and Morris are from the same field of endeavor of electronic presentation includes annotation to presentation material, and provides a predictable result of the bridging the gap between the virtual multimedia-based of the Internet word and the physical world of

Art Unit: 2176

printed media, wherein the annotated media may contain one or more of textual, audio, or video information, and the customer premises equipment ("CPE"), serving as the receiver, plays multimedia sequence (Schena col.1, lines 5-15, col. 1 line 64 through col. 2. line 40).

*Regarding **claims 9, 21, and 33**,*

Morris and Hoda do not expressly teach, but Schena teaches:

wherein a multimedia document is represented as a second Uniform Resource Locator (URL) printed on the first multimedia document, and wherein the image of the paper document and the multimedia annotation is accessed with the second URL,

(Schena col. 4, lines 45-55, discloses the link information corresponding to the provider information may include a universal resource locator (URL) (Schena col.1, line 64 through col. 2. line 40). In addition, the links can be encoded according to provider, for example UPC or ISBN numbers and any code may serve as the alphanumeric sequence.

Also See Schena at Col. 3 Lines 60-65, discloses high density barcodes.

Under the broadest reasonable interpretation, The Examiner equates the claimed **bar code** as equivalent to the UPC or ISBN numbers and any code as taught by Schena.

This interpretation is supported by Applicant's Specification, which states "*The annotation may be in different forms, such as, for example, a bar code containing an audio message or a URL indicating a link to a video clip*" at page 7 lines 15-18.)

Art Unit: 2176

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify schena's user selectable object (i.e. the location indicator comprises a first Uniform Resource Locator (URL), and a second bar code, wherein the first URL is indicated in plain text, and wherein the second bar code represents the first URL in an encrypted form) providing a user with access to the portion of the recorded information corresponding to the visual feature (i.e. machine readable barcode), to includes a means of selecting by a user onto a check box, the sub-type is defined as audio, video, image, text, or other type object scanned-in form, are stored in a mixed object document content architecture envelope (MODCA) as taught by Morris and Hoda. One of ordinary skill in the art would have been motivated to modify this combination because Schena and Morris are from the same field of endeavor of electronic presentation includes annotation to presentation material, and provides a predictable result of the bridging the gap between the virtual multimedia-based of the Internet word and the physical world of printed media, wherein the annotate media may contain one or more of textual, audio, or video information, and the customer premises equipment ("CPE"), serving as the receiver, plays multimedia sequence (Schena col.1, lines 5-15, col. 1 line 64 through col. 2. line 40).

*Regarding **claims 10, 22, and 34,***

Morris and Hoda do not expressly teach, but Schena teaches:

wherein a third bar code is used to represent a second URL

Art Unit: 2176

(Schena col. 4, lines 45-55, discloses the link information corresponding to the provider information may include a universal resource locator (URL) (Schena col.1, line 64 through col. 2. line 40). In addition, the links can be encoded according to provider, for example UPC or ISBN numbers and any code may serve as the alphanumeric sequence.

Also See Schena at Col. 3 Lines 60-65, discloses high density barcodes.

Under the broadest reasonable interpretation, The Examiner equates the claimed **bar code** as equivalent to the UPC or ISBN numbers and any code as taught by Schena. This interpretation is supported by Applicant's Specification, which states "*The annotation may be in different forms, such as, for example, a bar code containing an audio message or a URL indicating a link to a video clip*" at page 7 lines 15-18.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify schena's user selectable object (i.e. the location indicator comprises a first Uniform Resource Locator (URL), and a second bar code, wherein the first URL is indicated in plain text, and wherein the third bar code represents the second URL in an encrypted form) providing a user with access to the portion of the recorded information corresponding to the visual feature (i.e. machine readable barcode), to includes a means of selecting by a user onto a check box, the sub-type is defined as audio, video, image, text, or other type object scanned-in form, are stored in a mixed object document content architecture envelope (MODCA) as taught by Morris and Hoda. One of ordinary skill in the art would have been motivated to modify this combination because Schena

Art Unit: 2176

and Morris are from the same field of endeavor of electronic presentation includes annotation to presentation material, and provides a predictable result of the bridging the gap between the virtual multimedia-based of the Internet word and the physical world of printed media, wherein the annotate media may contain one or more of textual, audio, or video information, and the customer premises equipment ("CPE"), serving as the receiver, plays multimedia sequence (Schena col.1, lines 5-15, col. 1 line 64 through col. 2. line 40).

Regarding claims 11, 23, and 35, Morris teaches:

wherein the recipient is specified by a user via an interface of the document reproduction system when the user reproduces the paper document using the document reproduction system.

(See Morris at Col. 2, Lines 35-40, discloses scanned-in form, are stored in a mixed object document content architecture envelope (MODCA). Morris further discloses, if the box being defined is a check box, then the sub-type is defined as audio, video, image, text, or other type object. The resulting directory and the image object of the overall scanned-in form are stored in a mixed object document content architecture envelope (MODCA)-see Morris at Col. 2 Lines 20-30.)

Art Unit: 2176

In addition, Morris and Hoda do not expressly teach, but Schena teaches:

**automatically sending a second multimedia document to a recipient
by electronic mail as a part of reproducing the paper document via the
document reproduction system,**

(See Schena at Col. 4 lines 35, discloses the link information was published or located, along with message-specific information. The examiner equates the claimed automatically sending a second multimedia document to a recipient by electronic mail as equivalent to link information was published or located, along with a message as taught by Schena.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify schena's automatically sending a second multimedia document to a recipient by electronic mail as a part of reproducing the paper document, so that, a user can accessing a segment of video file which references scanned document as taught by Morris and Hoda. One of ordinary skill in the art would have been motivated to modify this combination because Schena and Morris and Hoda are from the same field of endeavor of electronic presentation includes annotation to presentation material, and provides a predictable result of the bridging the gap between the virtual multimedia-based of the Internet word and the physical world of printed media, wherein the annotate media may contain one or more of textual, audio, or video information, and the customer premises equipment ("CPE"), serving as the receiver, plays multimedia sequence (Schena col.1, lines 5-15, col. 1 line 64 through col. 2. line 40).

Claims 12, 24, and 36 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over **Morris** et al US005420974A issued 05/30/1995 (hereinafter Morris), in view of in view of **Hoda** et al US004831610 filed 03/03/1987 (hereinafter Hoda), further in view of **Schena** et al US006448979B1 filed 01/25/1999 (hereinafter Schena), and further in view of **Halliday** et al., US 5,880,740 filed 7/12/1996 (hereinafter Halliday).

Regarding claims 12, 24, and 36,

Morris, Hoda and Schena do not expressly teach, but Halliday teaches:

wherein the recipient receives the image of the paper document and the multimedia annotation in the form of Multi-purpose Internet Mail Extension (MIME).

(See Halliday at Col. 8 Lines 5-28, discloses MIME.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morris and Hoda teaching of using a scanner capable of receiving data such as machine-readable code from a printed medium, so that, when selected by a user the barcode would accessing a segment of video file which references scanned document as taught by Morris, to includes MIME functionality as taught by Halliday. One of ordinary skill in the art would have been motivated to modify this combination provide a predictable result of the bridging the gap between the virtual multimedia-based of the Internet word and the physical world of printed media, wherein the annotate media may contain one or more of textual, audio, or video information, and the customer premises

Art Unit: 2176

equipment ("CPE"), serving as the receiver, plays multimedia sequence (Schena col.1, lines 5-15, col. 1 line 64 through col. 2. line 40), and provides a composite document as a MIME attachment to an email message and sent via an conventional email utility, such as the popular Eudora, America Online, or Netscape Navigator mail programs (see Halliday at Col. 7, Line 39, and Col. 8 Lines 10-15).

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Arguments

Applicant's arguments with respect to claims 1, 4-5, 8-13, 16-17, 20-25, 28-29, 32-36, and 44-52 filed 09/09/2008 [see the Remarks Pages 12-16], have been considered but are moot in view of new ground of rejection presented in this Office Action and further view of the followings:

In addition, "What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the

Art Unit: 2176

predictable use of prior art elements according to their established functions." Id. at 1740.

In this case, the Examiner's analysis Morris discloses scanned-in form, are stored in a mixed object document content architecture envelope (MODCA), at Col. 3, lines 35-45. Morris further discloses at the Abstract, a multimedia document form system enables the definition, manipulation, storage and editing of a form which contains multimedia objects. For example an audio object will be entered in digitized form and stored in association with the form. When the form is then displayed on a visual display device, the corresponding check box is highlighted to indicate to the operator the presence of a nonvisual presentation object which is stored in association with the form. The operator can then select the check box with a mouse, and the system will then access the stored nonvisual object and play it back for the operator, See the Abstract.

In view of Schena's machine-readable code on the paper is used to communicate corresponding multimedia information when the machine-readable code is read by a scanner. The URL encoded in the machine-readable code points to a multimedia file. Thus, the machine-readable code on the printed medium annotates the printed medium with the referenced multimedia file, thus combining the printed medium with virtual multimedia. In combining the multimedia presentation with the printed medium, Schena has created a multimedia document of the claimed invention (See Schena the Abstract) and also Schena in col. 2 lines 6-8 that the multimedia annotation may contain one or more of textual, audio, or video information, and further in view of Halliday's teaching of

Art Unit: 2176

MIME (Multi-purpose internet mail), as for [claims 12, 24 and 36 only] at Col. 8, Lines 5-28.

As recognized by the Examiner, Morris, Schena, and Halliday do not expressly teach the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document as newly amended to claims 1, 13 and 25. On the other hand, in what is fairly characterized as analogous art in accordance the above-noted case law, Hoda's method discloses this limitation as cited above.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morris's check box and the sub-type is defined as audio, video, image, text, or other type object scanned-in form, are stored in a mixed object document content architecture envelope (MODCA), to include a means of utilizing the barcode as taught by Schena, further include Halliday's teaching of MIME (Multi-purpose internet mail) and the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document as taught by Hoda, so that, when selected by a user (i.e. scanned document with the box is check as taught by Morris) the barcode would accessing a segment of video file which references scanned document, and provides a predictable result of the bridging the gap between the virtual multimedia-based of the Internet word and the physical world of printed media, wherein the annotate media may contain one or more of textual, audio, or video information, and the customer premises equipment ("CPE"), serving as the

Art Unit: 2176

receiver, plays multimedia sequence (Schena col.1, lines 5-15, col. 1 line 64 through col. 2. line 40).

Accordingly, for at least all the above evidence claims 1, 4-5, 8-11, 13, 16-17, 20-23, 25, 28-29, 32-35, and 44-52 remain rejected at least at this time,

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on 9AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/526,031

Page 32

Art Unit: 2176

/Quoc A, Tran/

Patent Examiner

/Doug Hutton/

Doug Hutton

Supervisory Primary Examiner

Technology Center 2100